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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/423,025  
Filing Date: October 28, 1999  
Appellant(s): PETERSON ET AL.

\_\_\_\_\_  
Raymond E. Roberts (Reg. # 38,597)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed December 9, 2008 appealing from the Office action mailed June 12, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The advisory action dated August 7, 2008 indicated that the amendment filed July 28, 2008 will not be entered. However, this is an error and the amendment has been entered by the Examiner.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US Patent No. 5,646,992	Subler et al.	09-1993
US Patent No. 5,984,508	Hurley	06-1997

**(9) Grounds of Rejection**

1. The following ground(s) of rejection are applicable to the appealed claims:

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 12-15 and 26-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 12, 26 and 29 recites the limitation "all said keys". There is insufficient antecedent basis for this limitation in the claim. The Examiner is confused about the number of keys required to unwrap the digital wrapper. There is a possibility that the user can unwrap the digital wrapper using one key ("*receiving at least one key*"), which contradicts with, for example, the limitation ("*unwrapping said digital wrapper protecting said selection using all said keys required for said selection*") of claim 12. The Examiner suggests replacing the phrase "all said keys" with "said at least one key".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-15 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subler et al (US Patent No. 5,646,992) in view of Hurley (US Patent No. 5,984,508).

7. **As per claim 12:** Subler discloses the following limitations:

- a. wherein said assets are instances of the digital content and are protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping (see at least column 1, lines 5-6 and 62-63, column 7, lines 10-13, column 9, lines 32-48 and column 16, lines 20-27);
- b. subsequent to said delivery of said personal computer to said user, displaying on the personal computer information about said inventory (see at least column 3, lines 39-52);
- c. accepting a selection representing a particular said asset from said user (see at least column 5, lines 5-30);

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- d. transmitting money representing payment for said selection and an identifier associated with said selection from the personal computer to a clearing house, via a communications system (see at least column 3, lines 30-31 and column 4, lines 51-64);
  - e. receiving at least one key associated with said selection at the personal computer (see at least column 16, lines 20-26); and
  - f. unwrapping said digital wrapper protecting said selection using all said keys required for said selection (see at least column 15, lines 49-56).
8. Subler does not explicitly disclose an inventory of assets pre-stored in a hard drive, however, Hurley discloses storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user (see at least column 1, lines 8-27).
9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Subler's teachings to include the step of pre-storing digital content in the computer's hard-drive before its delivered to the user to 1) ensure the compatibility of the digital content with the computer configuration, 2) to restrict the usage of the digital content to only one computer hard drive and 3) to reduce the cost of delivering the digital content to the user by not using a storage media such as CD-ROM's.

10. **As per claim 13:** Subler discloses the following limitations:

- g. receiving at the personal computer a first said key from said clearing house (see at least column 10, lines 2-5);
- h. transmitting from the personal computer said first said key to a master server, via said communications system (see at least column 10, lines 5-11, column 15, lines 49-56 and column 18, lines 39-53); and
- i. receiving back at the personal computer a second said key from said master server (see at least column 10, lines 5-11 and column 15, lines 49-56).

11. **As per claim 14:** Subler discloses wherein said (b) through said (f) are performed using a graphical user interface that presents said assets metaphorically as merchandise and units of service in aisles of stores (see at least column 1, lines 31-40 and column 3, lines 46-52).

12. **As per claim 15:** Subler discloses wherein said graphical user interface further presents said stores metaphorically as a member of the set consisting of villages, town squares, shopping centers, and malls (the graphical user interface displays the hierarchically organized graphical representations of items or groups of items that are available to be ordered, see at least column 1, lines 31-40 and column 3, lines 46-52).

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13. **As per claim 26, 28, 29, 30 and 31:** the claims are rejected over Subler using the same rationale used in rejecting claim 12. Regarding the limitation "a logic in the to personal computer to..." recited in claim 26 and the limitation "executable software..." recited in claim 29 are also disclosed by Subler (see at least column 5, lines 19-30 and column 1, lines 25- 28).

14. **As per claim 27:** this claim is rejected based on the same rationale in claim 12 rejections shown above.

#### **(10) Response to Argument**

15. In response to the argument concerning entry of the amendment (page 11-VII (A)), Appellant argues that the amendment filed July 28, 2008 has been refused entry. However, the Examiner submits that it's an error and the amendment has been entered.

16. In response to the 112 2nd rejection argument (page 11-VII (B)), Appellant argues that the rejection is improper and should be withdrawn. However, the Examiner respectfully disagrees. Claim 1, for example, recites in part the following limitations:

e) receiving at least one key associated with said selection at the personal computer; and

f) unwrapping said digital wrapper protecting said selection using all said keys required for said selection.



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17. The Examiner has interpreted limitation (e) above such that only one key has been received (e.g. based on the recitation “receiving at least one key”). This received one key alone must be used in step (f) to unwrap the digital wrapper because it’s the only key received. However, step (f) as claimed recites “said keys”, which contradicts with the fact that only one key has been received in step (e) and therefore only one key is required to unwrap the digital wrapper not multiple keys according to step (f). Therefore, the phrase “said keys” renders the claim indefinite.

18. In response to the 103 rejection argument (page 12-VII (C)), Appellant argues that the Examiner failed to address the limitation of claim 12 that recites: “Storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user”. The Examiner respectfully disagrees. The Examiner has addressed every limitation presented in claim 12. A detailed explanation of claim 12 limitations and the teachings of the prior art of record is presented below:

19. As per claim 12: Subler discloses:

- a. Storing an inventory of assets (e.g. “valued items” and “non-valued items”) in a hard drive (e.g. “user database”) of a personal computer (e.g. user’s workstation) prior to delivery of said personal computer to a user (“end user **16**”) wherein said assets are instances of the digital content (e.g. “digital information” or ) and are protected (e.g. encrypted) from unauthorized use by a digital

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wrapper (e.g. encryption) requiring at least one key for unwrapping (e.g. decrypting or unlocking) (column 1, lines 5-6 and 62-63, column 4, lines 16- 38);

b. subsequent to said delivery of said personal computer to said user, displaying on the personal computer information about said inventory (column 3, lines 39-52; figures 5-8);

c. accepting a selection representing a particular said asset (e.g. “purchase order”) from said user (column 5, lines 5-30);

d. transmitting money representing payment for said selection and an identifier (e.g. I.D.) associated with said selection from the personal computer to a clearing house (e.g. “order taker **46**” or “order taking system **42**”), via a communications system (e.g. internet) (column 4, lines 51-64; figure 20);

e. receiving at least one key (e.g. “decryption key”) associated with said selection at the personal computer (column 2, lines 20- 46; column 5, lines 5- 18; figure 21); and

f. unwrapping said digital wrapper protecting said selection using all said keys required for said selection (column 10, lines 2- 20; column 14, lines 39-54).

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20. Subler further discloses storing a plurality of locked/ disabled or demo digital content items in a CD ROM, wherein said CD ROM is delivered to a user. The user inserts the CD ROM into the user's workstation and browses a plurality of content items stored in the CD ROM and makes a purchase order to order on or more of the content items. In response to the purchase order, the user receives a decryption key for installing or rendering the purchased content items (column 2, lines 10- 45).

21. Subler further discloses several means for delivering digital content (e.g. CD ROM and switched telephone network communication). What Subler does not specifically disclose is storing digital content in a hard drive of a personal computer (e.g. user's workstation) prior to delivery of said personal computer to a user. However, Hurley clearly discloses means for delivering digital content to a user, such as downloading content from the internet, CD ROM, floppy disk, personal computers hard drives or through broadcast media (Hurley: column 1, lines 16- 24; column 2, lines 50- 64). Therefore, Hurley discloses means for delivering digital content including; hard drives of a personal computer.

22. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Subler teachings to include additional means for delivering digital content to a user, such as presorting digital content on personal computers hard drives, as disclosed by Hurley, to ensure the compatibility of the digital content with the computer configuration, to restrict the usage of the digital

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content to only one computer hard drive and/or to reduce the cost of delivering the digital content to the user by not using a storage media such as CD-ROM's (Hurley: column 2, lines 28- 31).

23. In response to applicant's arguments against the references individually (pages 5- 15), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant has decided to analyze the secondary reference Hurley first, despite the fact that Hurley was utilized by the Examiner to disclose one means of delivering content to a user, which is not specifically disclosed by the primary reference Subler. As has been explained by the Examiner above and in previous communications, Both Subler and Hurley are directed to the marketing and delivering of locked digital content, wherein a user can obtain a key/ code to unlock the content (Subler: abstract; Hurley: abstract). Subler utilizes a CD ROMs to deliver the locked digital content, whereas Hurley utilizes personal computers hard drives. One of Hurley's motivations to pre-store or pre-install digital content on personal computers hard drives, being to reduce the cost of content delivery by not utilizing CD ROM's as delivery means (column 2, lines 28- 31).

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24. In response to applicant's arguments that Subler teaches nothing about digital content protection, the Examiner respectfully disagrees. Subler does clearly disclose encrypting digital content using an encryption key (column 2, lines 20- 28).

25. In response to Appellant's argument (page 16, line 26- 2 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (e.g. loading, executing and/ or installing digital content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Appellant, for example, argues (page 17, lines 6- 16): "Thus, Subler again (as throughout) is teaching delivering a CD-ROM. In contrast, claim 12 recites delivery of a hard drive in a PC (specifically one installed prior to delivery of the PC to a user). As is well known, the content of a CD-ROM is not displayed to a user of a personal computer unless special software is started that does this. It is not surprisingly that at col. 3, ln.10 39-52 (right where the Examiner has here cited), Subler teaches that its CD-ROM includes such software". However, The Examiner agrees and further submits that whether a CD ROM includes a software is irrelevant of the claimed invention. Appellant continues: "Although this applies to step b of claim 12, these points also apply to all of steps c-f. As is well known, the operating system of a PC permits easy and unimpeded access to what is in a hard drive of the PC, but not to what is in a CD-ROM. Both software and data in a hard drive (e.g., the assets of digital content in claim 12) are readily accessible on a PC. Claim 12 does not explicitly recite that steps b-f are performed by local software. [Intentionally so, to avoid

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the (e.g., the assets of digital content in claim 12) are readily accessible on a PC. Claim 12 does not explicitly recite that steps b-f are performed by local software". The Examiner however disagrees, because the arguments are directed to features which are not claimed.

26. For the sake of argument, the Examiner submits that a CD ROM, which is inserted into a personal computer is an integral part of said personal computer because the content of the CD ROM will eventually be loaded and executed by the personal computer. Further, the CD ROM, when inserted into the personal computer, acts as storage medium for the personal computer and therefore said CD ROM is interpreted by the Examiner to be the integral part of the personal computer. Alternatively, it's old and well known in the art that the CD ROM could be copied in full into the personal computer's hard drive and the content of the CD ROM is executed directly from the personal computer hard drive. Therefore, whether the digital content is executed from the CD ROM or from the personal computer's hard drive does not appear to distinguish the claimed invention from the prior art of record. Further, the Examiner has relied on a secondary reference, Hurley, which clearly discloses digital content being executed directly from personal computer's hard drive.

27. In response to Appellant's argument (page 18, lines 4- 5): "Subler teaches nothing here about transmitting money or anywhere about transmitting an identifier or using a financial clearing house". However, the Examiner respectfully disagrees. Subler

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clearly discloses transmitting money representing payment for said selection and an identifier (e.g. I.D. or item name) associated with said selection from the personal computer to a clearing house (e.g. "order taker **46**" or "order taking system **42**"), via a communications system (e.g. internet) (column 4, lines 51-64; figure 20). Figure 20 clearly shows digital content items and their identifiers (e.g. item **434**) and the associated purchase information (e.g. Item **430**).

28. In response to Appellant's argument (page 20, lines 12- 17): "the Examiner has further asserted that Subler discloses "unwrapping said digital wrapper protecting said selection using all said keys required for said selection (see at least column 15, lines 49-56)." However, this cite also does not support the assertion. Col. 15, ln. 49-56 merely teaches vendor-side key handling and methods to send a key to purchaser. There is nothing here about the user-side and use of keys there. However, the Examiner respectfully disagrees. Subler clearly discloses unwrapping said digital wrapper protecting said selection using all said keys required for said selection (column 10, lines 2- 20; column 14, lines 39-54).

29. In response to Appellant's argument (page 21, lines 5- 8): "However, neither Subler or Hurley teach these advantages. In fact, without additional features neither is capable of 1) or 2) when taken alone or taken in combination. In deed, it appears that these advantages can only been seen by the use of 20/20 hindsight based on Appellant's disclosure, and only then if one ignores the other deficiencies in theses

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references". However, the Examiner respectfully disagrees. Subler discloses several means for delivering digital content (e.g. CD ROM and switched telephone network communication). What Subler does not specifically disclose is storing digital content in a hard drive of a personal computer (e.g. user's workstation) prior to delivery of said personal computer to a user. However, Hurley clearly discloses means for delivering digital content to a user, such as downloading content from the internet, CD ROM, floppy disk, personal computers hard drives or through broadcast media (Hurley: column 1, lines 16- 24; column 2, lines 50- 64). Therefore, Hurley discloses means for delivering digital content including; hard drives of a personal computer, such delivering means are old and well known in the art based on Hurley's disclosure. Hurley further suggests reducing the cost of delivering the digital content to the user by not using a storage media such as CD-ROM's (Hurley: column 2, lines 28- 31).



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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

Respectfully submitted,

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Claim 12	Subler	Hurley
<p>Storing an inventory of assets in a hard drive of a personal computer prior to delivery of said personal computer to a user wherein said assets are instances of the digital content and are protected from unauthorized use by a digital wrapper requiring at least one key for unwrapping;</p>	<p>inventory of assets= valued and non valued items hard drive= user's database personal computer= user's workstation user=end user <b>16</b> digital content= digital information digital wrapper= encryption unwrapping= decrypting or unlocking</p> <p>Valued and non-valued items are encrypted and stored in a CD ROM, said CD ROM is delivered to a user, wherein the encrypted valued and non-valued items are decrypted with a decryption key (column 4, lines 16- 38);</p>	<p>inventory of assets= digital information or software</p> <p>hard drive= hard drive personal computer= computer system or computer <b>100</b></p> <p>Hurley clearly discloses means for delivering digital content, such means including storing /installing digital information/ software on the hard drive of a personal computers (Hurley: column 1, lines 16- 24; column 2, lines 50- 64; column 4, lines 6- 15).</p>
<p>subsequent to said delivery of said personal computer to said user, displaying on the personal computer information about said inventory ;</p>	<p>when the delivered CD ROM is inserted into the user's work station (e.g. the CD ROM becomes the integral part of the workstation), the valued and non valued items are displayed using a browser (column 3, lines 39-52; figures 5-8);</p>	
<p>accepting a selection representing a particular said asset from said user ;</p>	<p>The user orders a specific valued item, once the order has been accepted, a decryption information is transmitted to the user (column 5, lines 5-30);</p>	
<p>transmitting money representing payment for said selection and an identifier associated with said selection from the personal</p>	<p>Identifier= ID or item name clearing house = order taker <b>46</b> or order taking system <b>42</b> communications system=</p>	

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computer to a clearing house via a communications system ;	<p>internet</p> <p>The user transmits a purchase order <b>40</b> to order taking system <b>42</b>. Figure 20 shows the purchase order content. The figure shows the ordered valued items and their identifiers (e.g. item <b>434</b>) and the associated purchase information (e.g. Item <b>430</b>) (column 4, lines 51-64; figure 20);</p>	
receiving at least one key associated with said selection at the personal computer;	<p>Key= decryption key or simply a key</p> <p>Once the purchase order is accepted, a decryption information (e.g. key) associated with the ordered valued items is transmitted to the user (column 2, lines 20-46; column 5, lines 5- 18; figure 21)</p>	
unwrapping said digital wrapper protecting said selection using all said keys required for said selection.	<p>Unwrapping= decrypting or unlocking</p> <p>The user utilizes the received decrypting key to decrypt/ unlock the ordered valued item (column 10, lines 2- 20; column 14, lines 39-54).</p>	